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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,535	03/26/2004	David M. Binder	7226-207	8973

7590 01/28/2005
Clifford Chance US LLP
200 Park Avenue
New York, NY 10166-0153

EXAMINER

GIBSON, KESHIA L

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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20040125

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Office Action Summary	Application No. 10/810,535	Applicant(s) BINDER ET AL.	
	Examiner Keshia Gibson	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 28-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-5 and 28-39 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/26/04 and 9/3/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Pocknell (US 4,991,574).

In regard to Claim 1, Pocknell discloses a stretchable, supportive bandage comprising a gel layer **2** bonded to a stretchable carrier **3** (column 1, lines 57-61; Figure 1). Examiner considers the bonded surfaces of the gel layer **2** and carrier layer **3** to be the respective adhesion surfaces of each material. Furthermore, applicant is advised that the method of forming the product is not relevant to the issue of patentability of the product itself.

Therefore, this limitation has not been given patentable weight.

In regard to Claim 2, Pocknell discloses that the gel layer **2** comprises silicone (column 1, lines 57-61; Figure 1).

In regard to Claim 28, Pocknell discloses that the gel layer **2** may contain additives (column 2, lines 57-61).

In regard to Claim 29, applicant states that the formation of a sheet or roll is for manufacturing purposes and that the final shape of the claimed invention can be of limitless configurations (page 5, lines 8-13). The method of forming the product is not

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relevant to the issue of patentability of the product itself. Therefore, this limitation has not been given patentable weight.

3. Claims 1-2 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Fabo (US 5,891,076).

In regard to Claim 1, Fabo discloses a supportive, stretchable bandage comprising a gel layer **2,3** and a stretchable carrier **1** (Figure 1; column 3, line 62- column 4, line 13).

Again, the method of forming the product is not relevant to the issue of patentability of the product itself. Therefore, the limitation of bonding adhesion layers has not been given patentable weight.

In regard to Claim 2, Fabo discloses that the gel layer **2,3** comprises silicone (column 2, line 66 - column, line 4).

In regard to Claim 29, as discussed with Pocknell above, applicant states that the formation of a sheet or roll is for manufacturing purposes and that the final shape of the claimed invention can be of limitless configurations (page 5, lines 8-13). The method of forming the product is not relevant to the issue of patentability of the product itself.

Therefore, this limitation has not been given patentable weight.

4. Claims 1-2 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Fabo (US 5,340,363).

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In regard to Claim 1, Fabo discloses a supportive, stretchable bandage comprising a gel layer 2 and a stretchable carrier layer 1 (column 2, lines 4-16). Again, the process for forming the product by bonding adhesion layers has not been given patentable weight.

In regard to Claim 2, Fabo discloses that the gel layer 2 comprises silicone (column 2, lines 27-35).

In regard to Claim 28, Fabo discloses that the gel layer 2 may contain additives (column 3, lines 30-36).

In regard to Claim 29, again, the formation of the bandage into a sheet or roll has not been given patentable weight.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pocknell or Fabo ('076 or '363).

Pocknell and Fabo both disclose the claimed invention except for the carrier having an elastic modulus of about 50%. Although neither Pocknell nor Fabo discloses an elastic modulus of about 50%, both do teach stretchable bandages. Therefore, it would have been obvious to one of ordinary skill in the art to provide for a carrier with an elastic modulus of about 50%, since it has been held that where the general conditions of a

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claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

7. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fabo ('076) in view of Fabo ('363).

Fabo ('076) discloses that claimed invention except for the gel layer containing additives. As discussed above, Fabo ('363) teaches a bandage having a carrier layer 1 and a gel layer 2. Fabo goes on to teach that the gel layer may contain additives that relieve pain or stimulate wound repair. Thus, it would have been obvious to one of ordinary skill in the art to modify Fabo ('076) by incorporating additives into the gel layer as taught by Fabo ('363) since doing so would provide additional avenues for pain relief and wound repair stimulation for the patient.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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9. Claims 1-5, 29-31, and 33-39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 4 and 5 of copending Application No. 09/931,974. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 4-5 of the earlier copending application "anticipate" Claims 1-2, 4-5, 30, and 35-36 of the current application.

In regard to Claims 1-2, 4, and 30, the earlier application Claim 4 discloses a bandage to be fastened about a body part comprising a silicone gel layer and an elastic carrier layer made of the loop portion of a hook and loop fastener, while the current application Claim 1 claims a bandage comprising a gel layer and a stretchable carrier. The latter bandage further comprises a silicone gel in Claim 2 and a loop fastener carrier in Claim 4; these items are collectively disclosed again in Claim 30.

In regard to Claims 5 and 35-36, the earlier application Claim 5 claims that the bandage of Claim 4 further comprises a closure strip having a hook fastener for securing the bandage about a body part while the current application Claim 5 claims the same; these items are separately claimed again in Claims 35 and 36.

In regard to Claim 3 and 33, Claims 3 and 33 of the current application disclose a bandage having a modulus of about 50%, while the earlier application does not.

However, it would have been obvious to one of ordinary skill in the art to provide for a carrier with an elastic modulus of about 50%, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

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In regard to Claim 29 and 34, Claims 29 and 34 of the current application set forth a bandage that is in the form of a sheet or a roll, while the earlier application does not. However, the applicant states that the formation of a sheet or roll is for manufacturing purposes and that the final shape of the claimed invention can be of limitless configurations (page 5, lines 8-13). The method of forming the product is not relevant to the issue of patentability of the product itself. Therefore, this limitation has not been given patentable weight.

In regard to Claim 31, Claim 31 of the current application sets forth that the silicone gel is a cured polydiorganosiloxane resin, while the earlier application does not. However, it would have been obvious to one of ordinary skill in the art to create a silicone gel from a cured polydiorganosiloxane resin, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

In regard to Claim 37-38, Claim 37 of the present application sets forth that the bandage is wrapped around a joint or muscle and Claim 38 further claims that the joint is a knee, ankle, wrist, or an elbow; the earlier application does not. However, it has been held that a recitation with respect to the manner in which a claimed invention is intended to be used does not differentiate the claimed invention from prior art satisfying the claimed structural limitations.

In regard to Claim 39, Claim 39 of the present application discloses that the bandage can be used for veterinary applications, while the earlier application does not. However, it has been held that a recitation with respect to the manner in which a claimed invention

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is intended to be used does not differentiate the claimed invention from prior art satisfying the claimed structural limitations.

Thus, it is apparent that the more specific claims 4-5 of the earlier application encompass Claims 1-5, 29-31, and 33-39 of the current application. Following the rationale in *In re Goodman* cited in the preceding paragraph, where the applicant has once been granted a patent containing a claim for the specific or narrower invention, the applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 28 and 32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 4 of copending Application No. 09/931,974 in view of Fabo ('363).

As discussed above, Fabo ('363) teaches a bandage having a carrier layer 1 and a gel layer 2. Fabo goes on to teach that the gel layer may contain additives that relieve pain or stimulate wound repair. Thus, it would have been obvious to one of ordinary skill in the art to modify Claims 4 of the copending application by incorporating additives into the gel layer as taught by Fabo ('363) since doing so would provide additional avenues for pain relief and wound repair stimulation for the patient.

This is a provisional obviousness-type double patenting rejection.

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Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dillon (US 5,759,560), Cartmell et al. (US 5,501,661), and Fabo (US 5,540,922).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keshia Gibson whose telephone number is (571) 272-7136. The examiner can normally be reached on M-F 8:30 a.m. - 6 p.m., out of the office every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kg 1/25/05



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